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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR         | ATTORNEY DOCKET NO.        | CONFIRMATION NO. |
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| 09/497,071   | 02/02/2000  | Linda I. Hoffberg-Borghesani | LIH-14                     | 7065             |
| 90150  | 7590        | 08/06/2012                   |                            |                  |
| Ostrolenk Faber LLP<br>1180 Avenue of the Americas<br>New York, NY 10036 |             |                              | EXAMINER<br>SALCE, JASON P |                  |
|  |             |                              | ART UNIT                   | PAPER NUMBER     |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Notice of Non-Compliant  
Amendment (37 CFR 1.121)**

Application No.

09/497,071

Examiner

JASON SALCE

Applicant(s)

HOFFBERG-BORGHESE ET  
AL.

Art Unit

2421

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 25 April 2012 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
  - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
  - ☐ C. Other \_\_\_\_\_.
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims).
  - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☒ E. Other: (See Continuation Sheet).
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):  
\_\_\_\_\_

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

**TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:**

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

**Extensions of time** are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

**Failure to timely respond** to this notice will result in:

**Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

**Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

**Notice of Non-Compliant Amendment (37 CFR 1.121)**

The Board of Patent Appeals and Interferences affirmed the rejection(s) against claim(s) 155-161, 174, 176 and 177, but reversed all rejections against claim(s) 162-173, 175 and 178-193. The Board of Patent Appeals also affirmed the rejection against claim 177 regarding the 112 2nd rejection, the Board of Patent Appeals further entered a new grounds of rejection regarding dependent claims 175 and 178.

Applicant has further amended claims 155 and 177, however this is not permitted after reconsideration by the BPAI. MPEP 1214.01 states that when the Board makes a new rejection under 37 CFR 41.50(b), the appellant, as to each claim so rejected, has the option of reopening prosecution or request rehearing. Appellant has already chosen to request rehearing. Furthermore, Applicant has not attempted to amend dependent claims 175 and 178, which have been rejected by the BPAI. MPEP 1214.01 further states in section II that in regards to submitting a request for rehearing, "By proceeding in this manner, the appellant waives his or her right to further prosecution before the examiner".

The Examiner further notes that MPEP 1214.07 states that "sometimes an amendment is filed after the Board's decision which does not carry into effect any recommendation made by the Board and which presents a new or amended claim or claims. In view of the fact that prosecution is closed, the appellant is not entitled to have such amendment entered as a matter of right. However, if the amendment is submitted with a request for continued examination (RCE) under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e), prosecution of the application will be reopened and the amendment will be entered. See MPEP § 706.07(h), paragraph XI."

Therefore pursuant to MPEP 1214.01, 1214.06 and 1214.07, the amendment has been deemed non-responsive. If Applicant wishes to further prosecute claims 155-161, 174, 176, 177 in view of the Affirmance issued by the BPAI and claims 175 and 178 based on the rejection entered by the BPAI, Applicant must reopen prosecution.